

### **REMARKS**

Applicants respectfully request reconsideration of the rejections set forth in the Office Action mailed on January 13, 2003. Claims 61-63 have been withdrawn from consideration. Claims 64-66 have been added. Claims 31, 53-56 and 60-66 are pending.

Claim amendments were made to better define one embodiment of the invention, notwithstanding the Applicants' belief that the unamended claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals. None of the amendments to the claims is related to the statutory requirements of patentability unless expressly stated so herein. Applicants reserve the right to prosecute the originally filed claims in the future. The comments in the Office action are now addressed in turn.

#### ***Withdrawal from Consideration***

The Office has withdrawn Claims 61-63 from consideration as they are drawn allegedly to subject matter that is not originally presented. Applicants respectfully traverse.

In order for this withdrawal from consideration to be proper, the claim groups identified must be independent or distinct from one another. In addition, examining all claim groups in a single application must present a serious burden on the Examiner.

Applicants respectfully maintain that it would not place an undue burden on the Examiner to include Claims 61-63 with the other pending claims in this case. Applicants respectfully request that Claims 61-63 be rejoined with the pending claims.

#### ***Rejections under 35 U.S.C. § 112***

##### **First Paragraph**

Claims 31, 53, 54, 56, and 60 have been rejected under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention. Specifically, the Office maintains that the proviso in claim 31 does not have support in the instant disclosure. Applicants respectfully disagree and traverse this rejection.

Support for the proviso can be found, for example at page 14, which states that the R<sub>2</sub> and R<sub>2</sub>' groups may be the same or different and that when the R<sub>2</sub> and R<sub>2</sub>' are different, preferred

embodiments utilize only a single non-hydrogen R<sub>2</sub>. Support also can be found in the claims as filed which recite that the chiral center has an R-configuration.

Applicants request that the rejection be withdrawn.

#### Second Paragraph

Claims 53 and 54 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office argues that Claims 53 and 54 lack antecedent basis. Applicants have amended the claims to address the Examiner's concerns. Support for the amendment can be found, for example, at page 16. Applicants request that the rejection be withdrawn.

#### ***Claim Objections***

Applicants acknowledge with gratitude the indication that Claim 55 would be allowable if rewritten in independent form. Applicants have amended Claim 55 to place it in independent form.

#### ***Information Disclosure Statement***

The Office has indicated that the information disclosure statement filed September 10, 2002 fails to comply with 37 C.F.R. §1.98(a)(2) as the same IDS allegedly was not filed in the parent case USSN 09/699,047. Applicants respectfully disagree. As evidenced by the enclosed copy of the IDS with PTO 1449 and postcard submitted during prosecution of the '047 application, copies of the cited references were provided to the Office. Moreover, Applicants respectfully note that, contrary to the Examiner's assertion, these references were considered by the Examiner during prosecution of the '047 application. See, copy of PTO 1449 with Examiner's initials.

Accordingly, because the references listed on the IDS filed September 10, 2002, were either cited by the PTO, or submitted to the PTO in the USSN 09/699,047, under 37 CFR § 1.98(d) Applicants submit that copies need not be provided. The Examiner is requested to make these references of official record in this application.

**Conclusion**

The Applicants respectfully maintain that all pending claims are in condition for allowance. Therefore, the Applicants respectfully request a Notice of Allowance for this Application from the Examiner. Should any unresolved issues remain, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP

A handwritten signature in dark ink, appearing to read "Lauren L. Stevens", with a stylized flourish at the end.

Lauren L. Stevens, Ph.D.  
Reg. No. 36,691

P.O. Box 778  
Berkeley, CA 94704-0778  
(650) 961 8300